

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 3, 12-13 are rejected under 35 U.S.C. 102(b) over the patent to Lykes.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant has canceled claim 13 and introduced its features into claim 1.

Claim 1 as now amended, in addition to the original features, defines that the annular grooves are provided on an outer diameter of the stator.

Turning now to the prior art applied by the Examiner and in particular the patent to Lykes, it can be seen that in this reference the grooves, in particular "annular grooves" are provided on the inner diameter of the stators. Figures 1-3 show for example "enlarged bore or notch 16" as explained in column 4, lines 40-41, which extend axially along the air gap between the rotor core 10 and the stator core 4. Also, in the embodiment of Figures 4-6, the notch 26 is provided on the inner diameter

of the stator core 4 and formed so that it is open toward the air gap between the rotor core 10 and the stator core 4.

It is believed to be clear that this reference does not teach the new features of the present invention in the amended claim 1. As for the obviousness of the features, it is believed that a person of ordinary skill in the art who familiarized himself with the teaching of the patent to Lykes would find no hint or suggestion to provide annular grooves on the outer diameter of the stator cores 4 or 25. The outer diameter of the stator is located in Figure 4 for example completely above as identified with the reference numeral 25, or completely below in the drawings. On this outer diameter Lykes does not provide any annular grooves.

The annular grooves provided on the outer diameter of the stator are shown in the present application in particular in Figures 1 and 2, in which these annular grooves are identified with reference numeral 28 and 26. While it is not shown in Figures 1 and 2 that the bearing ring 2 is received in the annular grooves 28 and 29 on the outer diameter of the stator, it is described in detail on page 3, lines 24-29 and on page 4, lines 20-23. If the Examiner is of opinion that the showing of this particular feature is necessary, applicant will be pleased to provide such an additional Figure, in which it will be clearly shown that the bearing rings 2

are received in the openings 28 and 29 on the outer surface diameter of the stator.

When the electrical machine is designed in accordance with the present, it has the advantage that by forming the annular grooves on the outer diameter of the stator, the requirements for the manufacturing accuracy can be lower than when the support of the bearing ring is provided on the inner diameter of the stator. In accordance with the invention, therefore the ring gap with the stator and the rotor can be manufactured more accurately, without having the support of the bearing ring in the stator as an interfering feature with respect to the ring gap.

The claims were rejected over the patent to Lykes under 35 U.S.C. 102(b) as being anticipated. As was shown above, this reference does not disclose the new features of the present invention as now defined in the amended claim 1. In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Lykes does not disclose each and every element of the present invention as defined now in the amended claim 1.

As explained herein above, the present invention provides also for highly advantageous results which can not be accomplished by the device disclosed in the reference. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals in the case Ex parte Tanaka, Marushma, and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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